

REMARKS

Reconsideration is respectfully requested. No claims have been amended, cancelled, or withdrawn. Claims 1-22 are pending.

Applicants have not dedicated or abandoned any unclaimed subject matter and moreover have not acquiesced to any rejections made by the Patent Office. Applicants reserve the right to pursue prosecution of any presently excluded claim embodiments in future continuation and/or divisional applications.

DOUBLE PATENTING REJECTION

Claims 1-22 stand rejected under the judicially created doctrine of obviousness type double patenting over claims 1-14 U.S. Patent No. 6,818,787 to Gallop et al. (hereinafter referred to as “*Gallop*”) in view of WO 01/28978 to Bryans et al. (hereinafter referred to as “*Bryans*”).

The Legal Standard for Obviousness-Type Double Patenting

In an obviousness-type double patenting rejection, the Examiner must show that the rejected claims are an obvious variant of the claims of the cited patent. Double patenting requires a comparison of the claims at issue with the claims of the issued patent. As stated by the M.P.E.P.:

[a] double patenting rejection must rely on a comparison with the claims in an issued or to be issued patent, whereas an obviousness rejection based on the same patent under 35 U.S.C. § 102(e)/103(a) relies on a comparison with what is disclosed (whether or not claimed).
M.P.E.P. § 804 III.

An obviousness type double patenting rejection is “‘analogous to a failure to meet the non-obviousness requirement of 35 U.S.C. 103’ except that the patent principally underlying the double patenting rejection is not considered prior art.” M.P.E.P. § 804I.

The Legal Standard Applied to the Present Rejection

The Examiner fails to a *prima facie* case for obviousness-type double patenting on multiple grounds.

First, the Examiner improperly relies on the *Gallop* and *Bryan* disclosures rather than the *Gallop* claims. A double patenting rejection must be based on a comparison to the claims in the issued patent. The Examiner asserts that the *Gallop*

reference “claims the same pro-drug type carbamate derivatives of 1-aminomethyl-cyclohex-1-ylacetic acid which are GABA analogs used to treat epilepsy and other diseases of the CNS.” However, use of the GABA analogs to treat epilepsy and other diseases of the CNS is based on the *Gallop* specification, not the claims. Similarly, the assertion that *Bryan* “teaches the 1-aminomethyl-bicycloalk-1-ylacetic acids are known in the same therapeutic field as the instant claims” impermissibly relies on the teaching of *Bryan*, not claims 1-14 of the *Gallop* reference.

The Examiner asserts that the “the instant application claims carbamate type pro-drugs of 1-aminomethyl-bicycloalkyl-1-ylacetic acid,” and that *Gallop* “claims the same pro-drug type carbamate derivatives of 1-aminomethyl-cyclohex-1-ylacetic acid which are GABA analogs.” Contrary to the Examiner’s assertion, however, claims 1-14 of the *Gallop* reference are not the same type of compound. Claims 1-22 of the instant application are directed to a structure requiring bicycloalkyl substituents. Claims 1-14 of the *Gallop* reference disclose a cyclohexyl substituent. Bicycloalkyl substituents as claimed are not homologs of cycloalkyl substituents. The claimed compound is not a homolog of *Gallop* claims 1-14.

Moreover, there is no suggestion or motivation for one of ordinary skill in the art to modify claims 1-14 of *Gallop* to make the compounds and methods of claims 1-22 of the instant application. The Examiner has not pointed to a suggestion or motivation to alter the compounds of *Gallop*. Rather, the Examiner argues that *Gallop* claims pro-drug type carbamate derivatives that are used to treat epilepsy and other diseases of the CNS,” and that *Bryson* teaches compounds that “are known in the same therapeutic field as the instant claims.”

Assuming, *in arguendo*, that the Examiner can combine *Gallop* with *Bryson* in a double patenting rejection, the mere fact that the compounds of *Gallop* and *Bryson* can be used for similar purposes does not provide the requisite motivation or suggestion to modify the structure of *Gallop* with the specific bicyclic structure disclosed by *Bryson*. Rather, there must be an affirmative reason to alter the structure of *Gallop* with the specific bicycloalkyl structure taught by *Bryson*. The Examiner has provided such a reason. Absent a motivation or suggestion to alter the structure taught by *Gallop* with *Bryson*, the obviousness-type double patenting rejection is improper.

In sum, the compounds and methods of claims 1-22 are not obvious variants of the structure of claims 1-22 of *Gallop*. The Examiner not only impermissibly relies

on the *Gallop* and *Bryson* disclosures rather than the *Gallop* claims, he also fails to provide the any motivation or suggestion to combine the claims of *Gallop* and the disclosure of *Bryson* to make the presently claimed compounds and methods.

Applicants respectfully request that this ground for rejection be withdrawn.

REJECTIONS UNDER 35 U.S.C. § 103(a)

Claims 1-22 stand rejected under 35 U.S.C. § 103(a) over *Gallop* in view of *Bryans*.

Under 35 U.S.C. § 103(c)(1), *Gallop* cannot preclude patentability of the presently claimed invention under U.S.C. § 103.

35 U.S.C. § 103(c)(1) states:

[s]ubject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the claimed invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Gallop cannot be used in an obvious rejection under 35 U.S.C. § 103(a) if *the* reference could only qualify as prior art under 35 U.S.C. § 102(e), (f), or (g), and was owned by the same entity or subject to an obligation of assignment to the same entity as the instant application at the time the claimed invention was made.

1. Because *Gallop* is not a prior art reference under 35 U.S.C. §§ 102(a), (b), (c), or (d), *Gallop* could only be alleged prior art under 35 U.S.C. §§ 102(e), (f), or (g).

Gallop also is not prior art under 35 U.S.C. § 102(a). 35 U.S.C. § 102(a) requires that

the invention was ...patented or described in a printed publication ...before the invention thereof by the applicant for patent.
35 U.S.C. § 102(a)

The instant application was filed on December 11, 2003, and claims priority to provisional applications filed on December 11, 2002 and December 12, 2002, respectively. *Gallop* was published as US 2003/0176398 A1 on September 18, 2003, and issued November 16, 2004, well after the filing date and priority date of the

instant application. Because both the publication date and issue date of *Gallop* are after the priority date of the instant application, the *Gallop* reference is not a description in a printed publication before the presently claimed invention. As such, the *Gallop* reference is not prior art under 35 U.S.C. § 102(a).

Gallop is not a prior art reference under 35 U.S.C. § 102(b). 35 U.S.C. § 102(b) requires that:

the invention was patented or described in a printed publication... more than one year prior to the date of the application for patent in the United States.
35 U.S.C. § 102(b)

As discussed above, the publication and issue dates of *Gallop* occurred well after the priority date of the instant application. Because *Gallop* was not published or issued more than one year before the priority date of the instant application, *Gallop* is not a prior art reference under 35 U.S.C. § 102(b).

Gallop is not a prior art reference under 35 U.S.C. § 102(c), which addresses abandonment of inventions. Further, *Gallop* is not a prior art reference under 35 U.S.C. § 102(d) because it is not a patent or inventors certificate in a foreign jurisdiction filed more than twelve months before the instant application.

Therefore, *Gallop* could only be considered as alleged prior art under 35 U.S.C. §§ 102(e), (f), or (g).

2. Statement of Common Ownership

In accordance with the requirements to establish common ownership articulated in M.P.E.P. § 706.02(l)(2), the instant U.S. Patent Application No. 10/734,689 and the *Gallop* patent were, at the time the invention of the instant application was made, owned by Xenoport, Inc.

Therefore, according to U.S.C. § 103(c)(1), *Gallop* cannot preclude patentability of the presently claimed invention under U.S.C. § 103. Because this ground for rejection is improper, Applicants respectfully request that it be withdrawn.

CONCLUSION

Applicants respectfully submit that all pending Claims of the captioned Application satisfy all requirements for patentability and are in condition for allowance. An early indication of the same is therefore respectfully requested.



If the Examiner determines that prosecution of the instant application would benefit from a telephone interview, the Examiner is invited to call the undersigned attorney at (415)-781-1989.

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Respectfully submitted,

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